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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,193	12/31/2003	Debashish Purkayastha	I-2-0670.1US	9177
24374	7590	02/25/2005	EXAMINER	
VOLPE AND KOENIG, P.C. DEPT. ICC UNITED PLAZA, SUITE 1600 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103			JONES, PRENELL P	
			ART UNIT	PAPER NUMBER
			2667	
DATE MAILED: 02/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/750,193

Applicant(s)

PURKAYASTHA ET AL.

Examiner

Prenell P Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 26-30 is/are rejected.
- 7) ☐ Claim(s) 22-25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-21 and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Einola et al in view of Lucidarme et al.

Regarding claims 1-19 and 26-30, Einola discloses (Abstract, col. 3, line 3-12, col. 4, line 40 thru col. 7, line 65) a telecommunication network wherein the architecture include inter-working unit (IWU) couples RNC of UMTS to MSC, servicing in a wireless LAN (WLAN), GSM includes core network such as GPRS, Gateway GPRS, plurality of base stations, UMTS network, information element (IE), (Fig. 2, col. 5, line 13-66) mobile transmits to core network portion information relating to its capability to communicate with various networks (e.g. GSM or UMTS),

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MS (WTRU) sends GSM formatted signaling message containing new bit indicating its multi-network capability (dual GSM/UMTS capability) to the BSC, information element (IE) includes new bit such as Bearer Capability information element, (col. 6, line 24-41) utilizing a new Network Preference parameter may be a two bit binary word coded to indicate subscriber preferences and changes in the network, (col. 7, line 1 thru col. 8, line 67) utilization of a host of information elements such as UTRAN, UMTS AN CM, UMTS CN CM, GSM CLASSMARK, CLASSMARK Type 3, GSM AN CM and UTRAN to UTRAN. However, Einola is silent on wireless LAN (WLAN). In analogous art, Lucidarme discloses (Abstract, col. 1, line 6 thru col. 4, line 35) monitoring and measuring communications and traffic exchange in a cellular radio system whereby the architecture includes a network core, several broadband radio access networks (WLAN), plurality of mobiles (WTRU), plurality of fixed networks (WTRU), (col. 3, line 11-57) utilizing dual mode communication (packet mode and circuit mode), utilizing WLAN standard 802.11b and 802.11a, implementation of UMTS/GPRS network, and providing short message service (SMS). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to implement or combine a wireless LAN system with GPRS/UMTS transmission as taught by Lucidarme with the teachings of Einola for the purpose of maintaining a peer-to-peer communication wherein networks can handle their subscribers separately and networks can operate independently, packets for roaming user are processed wherein handoff delay and lost of data can be reduced.

Regarding claims 20 and 21, as indicated above, Lucidarme discloses (Abstract, col. 1, line 6 thru col. 4, line 35) monitoring and measuring communications and traffic exchange in a cellular radio system whereby the architecture includes a network core, several broadband radio access networks (WLAN), plurality of mobiles (WTRU), plurality of fixed networks (WTRU), utilizing

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WLAN standard 802.11b and 802.11a, implementation of UMTS and GPRS network.

Lucidarme further discloses (col. 3, line 11-57) MS, MSC, BSC, fixed node communicating between packet mode and circuit mode (first mode and second mode).

***Allowable Subject Matter***

4. Claims 22-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter: Although the prior art discloses a telecommunication network wherein the architecture include inter-working unit (IWU) couples RNC of UMTS to MSC, servicing in a wireless LAN (WLAN), GSM includes core network such as GPRS, Gateway GPRS, plurality of base stations, UMTS network, information element (IE), mobile transmits to core network portion information relating to its capability to communicate with various networks (e.g. GSM or UMTS), MS (WTRU) sends GSM formatted signaling message containing new bit indicating its multi-network capability (dual GSM/UMTS capability) to the BSC, information element (IE) includes new bit such as Bearer Capability information element, utilizing a new Network Preference parameter may be a two bit binary word coded to indicate subscriber preferences and changes in the network, utilization of a host of information elements such as UTRAN, UMTS AN CM, UMTS CN CM, GSM CLASSMARK, CLASSMARK Type 3, GSM AN CM and UTRAN to UTRAN, monitoring and measuring communications and traffic exchange in a cellular radio system whereby the architecture includes a network core, several broadband radio access networks (WLAN), plurality of mobiles (WTRU), plurality of fixed networks (WTRU), utilizing dual mode

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communication (packet mode and circuit mode), utilizing WLAN standard 802.11b and 802.11a, implementation of UMTS/GPRS network, and providing short message service (SMS) they fail to teach or suggest when the WTRU selectively receives a removable communication card inserted to WTRU for supporting a plurality of WLAN protocols provides a message network identifying the inserted communication card.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prenell P. Jones whose telephone number is 571-272-3180. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham can be reached on 571-272-3179. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Prenell P. Jones

February 22, 2005

A handwritten signature in black ink, appearing to read "Prenell Jones", is written over the typed name and date.